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IN THE

Supreme Court of the United States

OCTOBER TERM, 1975

No. 75-266

HYMAN KRAMER, doing business as
HY KRAMER ENTERPRISES,

Petitioner,

v.

DURALITE COMPANY, INC., and
G & A MACHINE WORKS, INC.,

Respondents.

SUPPLEMENTAL BRIEF FOR PETITIONER

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Petitioner files this supplemental brief in order to call the Court's attention to a new case and other intervening matters not available at the time of filing of the petition for certiorari.

Opinions Below

The supplemental opinion of the United States Court of Appeals for the Second Circuit is now reported at 514 F.2d 1076.

A NEW REASON FOR GRANTING THE WRIT

VI. The Court Should Review the Decisions Below Because These Decisions Are in Conflict With A More Recent Decision of the Court of Appeals for the Fifth Circuit on the Same Matter.

On July 28, 1975, the Court of Appeals for the Fifth Circuit handed down its decision in *Becton, Dickinson & Co.* v. *Sherwood Medical Industries, Inc.* This decision was first reported in a case comment in the *Patent, Trademark & Copyright Journal* of the Bureau of National Affairs, Inc., 241 PTCJ A-2, on August 21, 1975, two days after the petition herein was filed, and has not, as yet, been reported elsewhere. The case comment is reprinted in its entirety in the appendix to this supplemental brief.

While the Fifth Circuit in *Becton, Dickinson* found both of the patent owner's patents invalid, one because of obviousness and the other because of erroneous oaths of inventorship made to the Patent Office, it would not infer intentional fraud on the Patent Office from such error, inaccuracy or incorrectness.

> "Obviously on our holding of non-inventorship by Russo, the First and Fourth Oaths turn out to be erroneous. To establish that, however, is a long way from finding fraud or equivalent bad conduct by whatever milder name called."

The element of conscious misrepresentation was not established. Sherwood had not met its "heavy burden of proof".

This decision of the Fifth Circuit is in sharp conflict with the supplemental opinion of the Second Circuit in this case (appendix to petition for certiorari, p. 21a). Here, the Second Circuit declined even to consider argument of

Kramer's *good faith* in making his oath of inventorship to the Patent Office or the *truth* of the oath as being *"not the real issue"*. Instead, it inferred, from what it concluded to be false testimony by Kramer at trial as to other and immaterial matters, "that Kramer had defrauded the Patent Office" some eight years earlier when he subscribed his oath of inventorship.

> "In his brief on appeal and in his petition for rehearing, Kramer suggests that he was at least a co-inventor and entitled to a good faith belief in his own inventorship. . . . But Kramer's possible co-inventorship is not the real issue. At trial, Kramer testified that he singlehandedly developed the angles that were critical to the success of the device. However, two witnesses testified that Kramer made no contribution to the choice of angles. The judge concluded that Kramer was not telling the truth. From this, the court was justified in finding that Kramer had defrauded the Patent Office when he claimed to be the sole inventor."

The District Court did not once mention "angles" in its decision (appendix to petition for certiorari, pp. 1a-5a). Moreover, the same two witnesses alluded to by the Second Circuit both testified that Kramer expressely required them to maintain the only angle mentioned in the patent application to which Kramer's oath of inventorship pertained (appendix to petition for certiorari, pp. 31a, 38a, 46a).

Further Support for Petitioner's Reason IV for Granting the Writ

In its September 4, 1975, issue of the *Patent, Trademark & Copyright Journal*, 243 PTCJ A-6, the Bureau of National Affairs, Inc., published a rarely precedented comment on petitioner's as yet undecided petition for certio-